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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/633,356	08/01/2003	John P. Romeo	064198.0171 (SS00356)	3704
31625	7590	11/04/2005	EXAMINER	
BAKER BOTTS L.L.P. PATENT DEPARTMENT 98 SAN JACINTO BLVD., SUITE 1500 AUSTIN, TX 78701-4039			ESCALANTE, OVIDIO	
			ART UNIT	PAPER NUMBER
			2645	

DATE MAILED: 11/04/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/633,356	Applicant(s) ROMEO ET AL.	
	Examiner Ovidio Escalante	Art Unit 2645	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 August 2005.
2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-20 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This action is in response to applicant's amendment filed on August 4, 2005. **Claims 1-20** are now pending in the present application.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claim 20 is rejected under 35 U.S.C. 102(b) as being anticipated by Uppaluru US patent 5,915,001.

Regarding claim 20, Uppaluru teaches a method of providing a user with access to an Internet portal having associated content, (abstract), comprising the steps of:

providing the user with access to the Internet portal via an Internet link provided at a computer, (fig. 1; col. 2, lines 22-41; col. 6, lines 6-22);

providing the user with modemless access to the Internet portal content via a calling card number communicated from a telephone over the public switched telephone network (PSTN), (col. 9, lines 57-64);

providing means for receiving user input representing preference selections via the Internet link provided at the computer, (col. 6, lines 6-22; col. 19, lines 1-23; col. 17, lines 25-45); and

providing means for receiving user input representing preference selections via a calling card call on the PSTN made using the telephone, (col. 19, lines 1-23).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

6. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

7. Claims 1-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Uppaluru in view of Enzmann et al. US Patent 6,320,946.

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Regarding claims 1 and 2, Uppaluru teaches a method of providing a user with access to the content of an Internet portal, using the public switched telephone network (PSTN) and a modemless connection, (abstract; fig. 1; col. 2, lines 22-41), comprising the steps of:

receiving, at an interactive voice response (IVR) system, a telephone call from the user, dialed with a calling card number and incoming through the PSTN, (col. 9, lines 57-64);

for modemless Internet portal access, performing the following steps:

receiving IVR input from the user representing a password, (col. 3, lines 1-17; col. 19, lines 23);

providing the user with a preference selection menu, (col. 19, lines 1-23);

providing the user with a content selection menu, (col. 19, lines 1-23);

receiving IVR input from the user representing Internet content selection, (col. 19, lines 1-23);

communicating the content selection to an Internet server via modemless communications, (col. 15, lines 12-19; col. 19, lines 33-45);

translating the Internet content from text format to audio data, (col. 8, lines 16-24); and

transmitting the audio data to the user via the PSTN, (col. 8, lines 16-24; col. 17, line 59-col. 18, line 28).

While Uppaluru teaches of performing voice calls with the calling card Uppaluru does not specifically teach recognizing input from the user to select between a voice call and Internet portal access.

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In the same field of endeavor, Enzmann teaches recognizing input from the user to select between a voice call and Internet portal access and for a voice call, completing the telephone call to a destination telephone number, (abstract; col. 2, lines 6-17; col. 10, lines 23-39).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Uppaluru by providing access to telephony calls with the calling card so that the user can access both Internet and regular calls via the same access card. This will also simplify billing since the user is charged for both services under one account.

Regarding claims 3 and 12, Uppaluru, as applied to claims 2 and 11, teaches wherein the receiving step is performed with a wire line call from the user, (col. 6, lines 6-22).

Regarding claims 4 and 13, Uppaluru, as applied to claims 2 and 11, teaches wherein the receiving step is performed with a wireless call from the user, (col. 6, lines 6-22).

Regarding claims 5 and 14, Uppaluru, as applied to claims 2 and 11, teaches of the format being text, Uppaluru does not specifically teaches wherein the text format is XML format.

In the same field of endeavor, Enzmann teaches wherein the text format is XML format, (col. 9, lines 12-28).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the format of Uppaluru to include XML as taught by Enzmann so that the web site creator can create customized tags that are specific for them and their customers and so that any web page document that a calling party request can be retrieved for them.

Regarding claims 6 and 18, Uppaluru, as applied to claims 2 and 11, teaches wherein the IVR input is telephone keypad input, (col. 19, lines 6-7).

Regarding claims 7 and 19, Uppaluru, as applied to claims 2 and 11, teaches wherein the IVR input is voice input, (col. 19, lines 6-7).

Regarding claims 8,15 and 16, Uppaluru, as applied to claims 2 and 11, teaches wherein for modemless Internet portal access, the step of receiving IVR input is followed by the steps of providing an IVR menu of Internet content selections and of receiving IVR input representing an Internet content selection, (col. 19, lines 1-23).

Regarding claim 9, Uppaluru, as applied to claim 2, teaches wherein the Internet content is email messages, (col. 9, lines 48-56).

Regarding claims 10 and 17, Uppaluru, as applied to claims 2 and 11, teaches presenting the user with an option to change portal preferences and of receiving IVR input representing one or more preference settings, (col. 2, lines 42-52; fig. 5).

Regarding claim 11, Uppaluru teaches a system for accessing the content of an Internet portal database served by a portal server, using the public switched telephone network and a modemless connection, (col. 19, lines 1-23; abstract), comprising:

a text-to-speech translator for receiving Internet content from the Internet portal database via modemless communications and for translating text representing the Internet content to audio data, (col. 8, lines 16-24); and

a interactive voice response (IVR) system operable to receive an incoming calling card call via the public switched telephone network (PSTN), (col. 9, lines 57-64), and to instruct the portal server to retrieve the Internet content and deliver the Internet content to the text-to-speech translator via modemless communications, (col. 8, lines 16-24).

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While Uppaluru teaches of performing voice calls with the calling card and using the card for Internet access, Uppaluru does not specifically teach recognizing whether the call is to be completed as a telephone call or for access to Internet content.

In the same field of endeavor, Enzmann teaches recognizing input from the user to select between a voice call and Internet portal access and for a voice call, completing the telephone call to a destination telephone number, (abstract; col. 2, lines 6-17; col. 10, lines 23-39).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Uppaluru by providing access to telephony calls with the calling card so that the user can access both Internet and regular calls via the same access card. This will also simplify billing since the user is charged for both services under one account.

Response to Arguments

8. Applicant's arguments filed August 4, 2005 have been fully considered but they are not persuasive.

Regarding claims 1-19:

Applicants contend that Uppaluru and Enzmann fail to teach at least "recognizing IVR input from the user to select between a voice call and modemless Internet portal access since Enzmann does not teach or suggest providing a user modemless Internet portable but instead teaches of using a modem. The Examiner respectfully disagrees.

While the Examiner agrees that Enzmann uses a modem, the modemless feature is supported by the primary reference. Enzmann was primarily used for the teaching of selecting

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between voice call and Internet. Since Uppaluru provides for a user to use a phone to access the Internet without a modem then the amended claims remain rejected under Uppaluru.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Enzmann was used for the teaching of recognizing input between voice call and Internet call. The Examiner believes that one of ordinary skill in the art can easily change the menu feature of Uppaluru to include this since the user is already accessing the system via a phone and for the reasons set forth in the rejection of this claim.

Regarding claim 20:

Applicants contend that Uppaluru does not teach or suggest providing a user access to an Internet portal or Internet portal content from both (a) a computer via an Internet link, and (b) a telephone, via a modemless link and providing a user means for receiving user input regarding preference selections via both (a) a computer, via an Internet link, and (b) a telephone, via a modemless link and receiving user input regarding preference selections via both (a) a computer, via an Internet link and (b) a telephone since Uppaluru merely teaches providing a user access to a voice web via a telephone connection to the Internet. The examiner respectfully disagrees.

In col. 6, lines 1-22, Uppaluru teaches "Telephone 111 is any voice enabling telecommunication device. Exemplarily telephones include...computer configured to operate as

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a telephone...” and “Alternatively a subscriber may access voice web pages...using another computer...”. Therefore, Uppaluru can access the web pages via Internet link and telephone and all features that are performed by the telephone can also be performed by any computer.

Conclusion

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

10. Any response to this action should be mailed to:

Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

or faxed to:

(571) 273-8300, (for formal communications intended for entry)

Or:

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(571) 273-7537, (for informal or draft communications, please label "PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to:

Customer Service Window
Randolph Building
401 Dulany Street
Alexandria, VA 22314

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ovidio Escalante whose telephone number is 571-272-7537. The examiner can normally be reached on M-Th from 6:30AM to 4:00PM. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan S Tsang can be reached on 571-272-7547. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

OVIDIO ESCALANTE
PATENT EXAMINER

Ovidio Escalante

Ovidio Escalante
Examiner
Group 2645
October 19, 2005

O.E./oe